

REMARKS

Claims 1-20 are pending in the present application.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over at least U.S. Patent No. 6,069,648 (“Suso”) in view of U.S. Patent No. 6,718,298 B1 (“Judge”), and further in view of U.S. Patent No. 6,720,863 B2 (“Hull”), and yet still further in view of Japan Patent Document No. JP 362167645 A (“Ise”). Applicant respectfully traverses the rejection for at least the reasons as set forth below.

Teaching Deficiencies

Claim 1 recites, in part, “recording a set of data frames according to the chosen recording mode, the recorded set of data frames comprising a downlink voice signal, a downlink video signal, an uplink voice signal and an uplink video signal in which the downlink video signal is recorded at the mobile set when the downlink voice signal is determined to have voice activity and in which the uplink video signal is recorded at the mobile set when the uplink voice signal is determined to have voice activity”.

None of at least Suso, Judge and Ise teaches that the recorded set of data frames comprises a downlink voice signal, a downlink video signal, an uplink voice signal and an uplink video signal.

The Office Action alleges that this is taught in Suso at FIG. 8(b) and col. 7, lines 10-35. Suso at FIG. 8(b) merely shows a self-image 25a and an image 25b from the other side. In each case, it is merely a photograph. There is no *video* signal illustrated and, in particular, there is no *uplink video* signal or *downlink video* signal illustrated. Suso at col. 7, lines 10-35 again merely describes self-image 25a and image 25b from the other side. Suso at col. 7, lines 10-35 also describes the other-side/self button 25c which merely switches display modes between (1) self-image and other image; (2) only self-image; (3) only other image. Again, there is no *video* signal described and, in particular, no *uplink video* signal or *downlink video* signal described.

Neither Judge nor Ise, as asserted, make up for the teaching deficiencies of Suso, as alleged. In addition, Hull does not make up for the teaching deficiencies of Suso for at least the reasons as set forth below. Therefore, the obviousness rejection cannot be maintained.

Prohibition of Proposed Modification of Suso

In addition, M.P.E.P. § 2143.01(VI) states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

It is respectfully submitted that FIG. 6 of Suso illustrates the exemplary principle of operation of the invention in Suso. The attention of the Examiner is respectfully directed to Suso at col. 4, line 63 to col. 5, line 15, which describes that cursor button 15 sequentially moves cursor 17 from choice 1 to choice 2 to choice 3. Once the cursor is on one of the choices, the determination button 16 selects the one and only one choice.

Thus, it is clear from the description in Suso and FIG. 6 of Suso that the invention in Suso, namely, an information communication terminal device can only be operating in one and only one mode at a time. In other words, without changing the principle operation of the invention in Suso, the information communication terminal device in Suso cannot record in “recording mode” and be in the middle of a telephone conversation in “transmission/reception mode”.

Thus, the proposed modification of Suso in view of the other cited documents cannot be maintained since the proposed modification would “change the principle of operation of the prior art invention being modified”. M.P.E.P. § 2143.01(VI).

M.P.E.P. § 2143.01(VI) concludes that, if the proposed modification of Suso would change the principle of operation of the Suso invention being modified, then the teachings of Suso, Judge and Ise are not sufficient to render the claims *prima facie* obvious.

For at least the reasons as set forth below, it is believed that a *prima facie* case of obviousness has not been presented with respect to independent claim 1 and its rejected dependent claims 2, 7-9, 12 and 13.

The same or similar arguments that were made with respect to independent claim 1 are made, if applicable, with respect to independent claims 3 and 4.

For at least the reasons as set forth below, it is believed that a *prima facie* case of obviousness has not been presented with respect to independent claims 3 and 4 and their rejected dependent claims 5, 6, 10, 11 and 14-20.

Antedating Hull

In addition, Applicant respectfully submits that Hull is not prior art with respect to the present application. Hull has an actual filing date of August 16, 2001. The present application is a divisional of U.S. Patent Application No. 09/747,392, filed December 22, 2000, now U.S. Patent No. 7,136,630 B2. Thus, the present application antedates Hull.

Therefore, Hull is not prior art with respect to the present application.

Since the rejection under 35 U.S.C. § 103(a) with respect to claims 1-7, 9 and 13-20 is based on at least Hull, it is respectfully submitted that a *prima facie* case of obviousness has not been presented.

It is therefore respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 1-20.

Concluding Remarks

Applicant does not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicant respectfully reserves the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

U.S. Application No. 10/651,428, filed August 29, 2003
Attorney Docket No. 17405US04
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In Response to Office Action mailed March 11, 2009

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: August 11, 2009

Respectfully submitted,

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